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Request
For
Continued Examination (RCE)
Transmittal

Address to:
Mail Stop RCE
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450A

Application Number	09/820,778
Filing Date	March 30, 2001
First Named Inventor	Hiroshi NAGASAWA
Art Unit	1637
Examiner Name	J. Siew
Attorney Docket Number	NAGASAWA5

This is a Request for Continued Examination (RCE) under 37 C.F.R. § 1.114 of the above-identified application.
Request for Continued Examination (RCE) practice under 37 CF R 1.114 does not apply to any utility or plat application filed prior to June 8, 1995, or to any design application. See Instruction Sheet for RCEs (not to be submitted to USPTO) on page 2.

1. **Submission required under 37 C.F.R. 1.114** Note: If the RCE is proper, any previously filed unentered amendments and amendments enclosed with the RCE will be entered in the order in which they were filed unless applicant instructs otherwise. If applicant does not wish to have any previously filed unentered amendment(s) entered, applicant must request non-entry of such amendment(s).

- a. ☒ Previously submitted. If a final Office action is outstanding, any amendments filed after the final Office action may be considered as a submission even if this box is not checked.
- i. ☐ Consider the arguments in the Appeal Brief or Reply Brief previously filed on _____
- ii. ☐ Other _____
- b. ☒ Enclosed
- i. ☐ Amendment/Reply
- ii. ☐ Affidavit(s)/Declaration(s)
- iii. ☐ Information Disclosure Statement (IDS)
- iv. ☒ Other Communication

2. **Miscellaneous**

- a. ☐ Suspension of action on the above-identified application is requested under 37 CFR 1.103(c) for a period of _____ months. (Period of suspension shall not exceed 3 months; Fee under 37 CFR 1.17(i) required).
- b. ☐ Other _____

3. **Fees** The RCE fee under 37 CFR 1.17(e) is required by 37 CFR 1.114 when RCE is filed.

- a. ☐ The director is hereby authorized to charge the following fees, or credit any overpayments, to Deposit Account No. 02-4035
- i. ☒ RCE fee required under 37 CFR 1.17(e)
- ii. ☒ Extension of time fee (37 CFR. 1.136 and 1.17) (☐ \$ _____ already paid for _____ month(s) extension of time on _____)
- iii. ☐ Other _____
- b. ☐ Check in the amount of \$ _____ enclosed (Check No. _____)
- c. ☒ Payment by credit card (Form PTO-2038 enclosed) authorized in the amount of \$ 1,220.00

WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.

4. ☒ Provisional extension of time if needed. Applicants authorize any charge of additional fees (except issue fee) that may be required in connection with this application to Deposit Account No. 02-4035.

SIGNATURE OF APPLICANT, ATTORNEY, AGENT REQUIRED

Name (Print/Type)	Roger L. Browdy	Registration No. (Attorney/Agent)	25,618
Signature		Date	October 19, 2004

CERTIFICATE OF MAILING OR TRANSMISSION

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Mail Stop RCE, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, or facsimile transmitted to the U.S. Patent and Trademark Office on the date shown below.

Name (Print/Type)		Registration No. (Attorney/Agent)	
Signature		Date	



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Atty. Docket: NAGASAWA=5

In re Application of:)	Conf. No.: 3579
)	
Hiroshi NAGASAWA et al)	Art Unit: 1637
)	
Appln. No.: 09/820,778)	Examiner: J. Siew
)	
Filed: March 30, 2001)	Washington, D.C.
)	
For: REACTIVE PROBE CHIP,)	October 19, 2004
COMPOSITE SUBSTRATE AND)	
METHOD FOR FABRICATION ...))	

COMMUNICATION

Honorable Commissioner for Patents
U.S. Patent and Trademark Office
2011 South Clark Place
Customer Window, Mail Stop RCE
Crystal Plaza Two, Lobby, Room 1B03
Arlington, VA 22202

Sir:

The present communication is responsive to the Advisory Action of September 8, 2004, and accompanies the filing of a Request for Continued Examination. In the Advisory Action of September 8, 2004, the examiner stated that the newly-added limitation "with the proviso that the porous carrier of said first and second carrier probes is other than silica gel" does not have support in the specification and, thus, it constitutes new matter. This statement of the examiner is respectfully traversed.

This is the type of proviso that falls squarely within the fact situation described MPEP §2173.05(i) and in *In*

re Johnson, 194 USPQ 187, 196 (CCPA 1977). MPEP §2173.05(i)

(Rev. 2, May 2004), states:

Any negative limitation or exclusionary proviso must have basis in the original disclosure. If alternative elements are positively recited in the specification, they may be explicitly excluded in the claims. See *In re Johnson*, 558 F.2d 1008, 1019, 194 USPQ 187, 196 (CCPA 1977) ("[the] specification, having described the whole, necessarily described the part remaining."). See also *Ex parte Grasselli*, 231 USPQ 393 (Bd. App. 1983), *aff'd mem.*, 738 F.2d 453 (Fed. Cir. 1984).

In re Johnson, *supra*, states at 196:

The notion that one who fully discloses, and teaches those skilled in the art how to make and use, a genus and numerous species therewithin, has somehow failed to disclose, and teach those skilled in the art how to make and use, that genus minus two of those species, and has thus failed to satisfy the requirements of §112, first paragraph, appears to result from a hypertechnical application of legalistic prose relating to that provision of the statute. All that happened here is that appellants narrowed their claims to avoid having them read on a lost interference count.

Here, applicants are limiting the claims to exclude silica gel, which is disclosed in the prior art. As applicants have fully disclosed and teach how to make and use each of a number of species within the genus, one of which is silica gel, then, as stated in *In re Johnson*, applicants have also disclosed and taught how to make and use that genus minus the one species. Thus, in accordance with both *In re Johnson* and the MPEP,

which the examiner is bound to follow, a specification containing a genus including a number of species provides full written description for that genus minus one of those species. That is exactly what is being claimed in the present claims. The proviso is not new matter, i.e., does not fail to comply with the written description requirement of the first paragraph of 35 U.S.C. §112. Accordingly, when considering applicants' amendment of August 20, 2004, on the merits, it is urged that the examiner withdraw the statement that the newly-added proviso does not have support in the specification.

Consideration of applicants' amendment of August 20, 2004, and allowance of all the claims now present in the case are therefore earnestly solicited.

Respectfully submitted,

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By


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